IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

BAUSCH & LOMB OPTICAL CO.,
Petitioner,

v.

DEAN A. LYON,
Respondent.

No. 379

SUPPLEMENT TO PETITION FOR REHEARING OF ORDER DENYING WRIT OF CERTIORARI

Permission is requested to file this supplement to the Petition for Rehearing filed on or about December 29, 1955, in order to include consideration of an intervening editorial comment on the decision below. The comment entitled "1952 Patent Act Held To Change Standard of Invention" appears in the Columbia Law Review, Vol. 55, No. 8, December, 1955 commencing at page 1231. This issue was received after the filing of the Petition for Rehearing.

This comment is relied on as further showing not only the widespread interest in the decision below but the conflict of the decision below with the courts of appeals of other circuits and the resulting confusion in applying the 1952 Act to all unexpired patents, both as regards the proper standard of invention to be employed and the retroactive effect of the Act.

After statement of the case, the Law Review commented on the decision below as follows (pp. 1233-4):

"In the instant case, the court recognized that the process would have been held to lack invention had the case arisen immediately prior to 1952. On the other hand, invention would have been found, the court stated, if the process had been in question in the years before the Supreme Court adopted its more demanding requirements. The court reasoned that a statute should not be interpreted under the assumption that no change was intended unless it clearly appears to be a codification of existing law. In the court's view the latter possibility was negated in the instant statute by section 4(a) which states that the act is to apply retroactively to patents previously granted.[13] The court reasoned that there would have been no need to include section 4(a) in the absence of an intent to change. Finding additional support in the statement by the Revisor,[14] the court felt compelled to take the statute as it read and held that by incorporating this original Supreme Court test in the statute Congress had intended to restore the law to what it was when the standard was first originated.

"Although no specific legislative intent is clear, it would seem that the act was not intended to be solely a codification of existing law.[15] The retroactivity argument supports this proposition although it does seem to be overly relied upon by the instant court; specific changes in the law were made,[16] and it cannot be said with any certainty that section 4(a) was not intended to apply solely to those changes. Nevertheless, the over-all view of the instant court is reasonable. Since the act is not solely a codification, it was proper for the court to invoke the rules of statutory interpretation to discover its meaning.

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[13]66 STAT. 815 (1952).

[14]See note 12 *supra*.

[15]See H.R. REP. No. 1923, 82d Cong., 2d Sess. 1 (1952); 98 CONG. REC. 9323 (1952).

[16]See, *e.g.* 35 U.S.C. § 271 (1952).

"The hearings on the act show that Congress was dissatisfied with the attitude of the Supreme Court toward patents,[17] thereby indicating that Congress did not desire to continue the Court's interpretation of the standard of invention. The Revisor's note quoted by the instant court supports the view that a fresh start was intended.[18] While there is no direct legislative support for the instant court's return to the 1850 interpretation, the choice was a reasonable one. There was no clear intermediate point at which the court could have rested, and the Revisor's note indicates that Congress certainly did not intend to adopt a greater liberality than that of the Patent Office.[19] It was, therefore, probably best to take the plain meaning of the statutory standard with the attitude of its originators as a guide.

"In spite of the hope expressed by the Revisor the new standard of invention has not been helpful in clarifying the law. It appears to have caused even more confusion than existed previously since no other court has agreed with the instant court in its interpretation.[20] Congress should make its position clear, basing its establishment of a definite standard of invention on an evaluation of the relevant policy considerations. A strict standard might affect incentive and cause an inventor to choose secrecy rather than a patent. On the other hand, a lenient standard might make it possible for a corporation to build a pyramid of patents based upon

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[17]See *Hearings Before Subcommittee No. 3 of the House Committee on the Judiciary on H.R. 3760*, 82nd Cong., 1st Sess., ser. 9, at 134-35.

[18]See note 12 *supra*.

[19]*Ibid.*

[20]*E.g.*, Stanley Works v. Rockwell Mfg. Co., 203 F.2d 846, 849 (3d Cir. 1953) (dictum); General Motors Corp. v. Estate Store Co., 203 F.2d 912, 915 (6th Cir. 1953) (dictum); Gagnier Fibre Products Co. v. Fourslides, Inc., 112 F. Supp. 926 (E.D. Mich. 1953); Thys Co. v. Oeste, 111 F. Supp. 665 (N.D. Cal. 1953), *aff'd per curiam*, 219 F.2d 131 (9th Cir. 1955)."

the development of a single basic process and thereby maintain exclusive control of the field."

Respectfully submitted,

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I hereby certify that the foregoing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58(a).

Respectfully submitted,

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Attorney for Petitioner